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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,466	10/26/2001	Alison Salyer Bagwell	16373	7830

23556 7590 05/18/2004

KIMBERLY-CLARK WORLDWIDE, INC.  
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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/010,466	Applicant(s) BAGWELL ET AL.	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/18/02; 06/03/02 & 07/25/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 14-30 and 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 2, 3 & 5-7 is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                                       |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/18/02; 7/25/03</u> . | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

**Election/Restrictions**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 & 31-33, drawn to an aqueous coating formulation, classified in class 524, subclass 215.
  - II. Claims 14-16 & 34, drawn to an aqueous imbibing solution, classified in class 106, subclass 287.23.
  - III. Claims 17-26 & 36, drawn to a method of treating a substrate and article therefrom, classified in class 427, subclass 385.5.
  - IV. Claims 27 & 35, drawn to a method of treating a substrate, classified in class 427, subclass 385.5.
  - V. Claims 28-30, drawn to a method of producing a printed substrate and printed substrate therefrom, classified in class 427, subclass 314.
2. The inventions are distinct, each from the other because:
3. Inventions Group II and Group I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a fabric treating agent devoid of a cationic polymer or copolymer and a fabric softener and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. The intermediate product(Group II) is in mutually exclusive relationship with the final product(Group I) as per presumably a reaction taking place

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between the components of the Group II invention and the components a) and b) and other silent ingredient(s) of the Group I invention engendering a final product structurally different from the intermediate product, i.e., the intermediate product(Group II) loses its identity upon formation of the final product(Group I).

4. Inventions Group I and Group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product, as claimed, can be used in an entirely different process such as in a process for forming a molded article.

5. Inventions Group I and Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as a process which involves coating a fabric without further use of a subsequent printing and post treatment step.

6. Inventions Group III and Group IV are separate and distinct, each from the other, as per being related as mutually exclusive species, each not requiring the particulars of the other for patentability, i.e., they comprise different method steps such as treating a substrate by a one step application(Group III) v. a two step application(Group IV).

7. Inventions Group IV and V are separate and distinct, each from the other, as per being related as mutually exclusive species, each not requiring the particulars of the other for patentability, i.e., they comprise different method steps and different ingredients.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. This application contains claims directed to the following patentably distinct species of the claimed invention: (a) the instant cationic polymer or copolymer (Groups I & III) including polydiallyldimethylammonium chloride-co-diacetone acrylamide (claims 1-13, 17-33, 35 & 36 & Example 1), (b) the instant fabric softener (Groups I & III) including Varisoft 222, Tradname, (claims 1-13, 17-33, 35 & 36 & Example 1), (c) tanning agent (Groups I-III & V) including ethylene glycol monoethyl ether and thiodiethylene glycol (claims 9-11, 13, 18, 19, 29, 32 & 33) and (d) ammonium salt which includes ammonium oxalate (claims 1-36, Groups I-V) and ammonium tartrate (claims 31 & 34-36, Groups I, II, III & IV).

Applicant is required under 35 U.S.C. 121 to elect a single ultimate disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-13 & 17-36 are generic. Where specific species are not identified in the claims, applicant should elect specific specie from the specification. An alternative method of election is to identify an Example, which collectively exemplifies the elected species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. During a telephone conversation with Mr. James B. Robinson on 04/26/04 a provisional election was made with traverse to prosecute the invention of Group I/(a) poly(diallyldimethylammonium chloride-co-diacetone acrylamide), (b) Varisoft 222(Tradename), (c) ethylene glycol monoethyl ether and (d) ammonium oxalate species, claims 1-13 & 31-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-30 & 34-36 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. There is no single claim drawn to the elected species.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### Information Disclosure Statement

13. The information disclosure statements filed on 04/18/02 & 07/25/03 have been considered and scanned into the application file.

#### Drawings

14. The drawings filed on 10/26/01 are acceptable for examination purposes.

#### Specification

15. The disclosure is objected to because of the following informalities: The use of the at least trademarks "Airflex 540", "PrintRite 591", "Varisoft 222" "Varisoft 475", "Q2-5211", "Reten 204LS" & "Adogen 432", pages 15-44, have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. Identification of the trade names may be introduced by amendment but it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter. See M.P.E.P ' 608.01(v).

Appropriate correction is required.

#### Claim Objections

16. Claims 2, 3, 5-7 & 11 are objected to because of the following informalities: The "weight" unit, governing the amounts in each of said claims, has been omitted. Appropriate correction is required.

#### Claim Rejections - 35 USC § 112

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1-13 & 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A) The recited "polymer or copolymer" per claims 1, 12 and 31 constitutes indefinite subject matter as per it not being readily ascertainable as to how "copolymer" differentiates over "polymer". Does applicant intend "homopolymer" instead of "polymer"?
- B) The recited "between about 5 to 95%" per claim 2, "between about 5 to 20%" per claim 3, and "between about 0 to 80%" per claim 5 constitutes indefinite subject matter as per "to" being inconsistent with the qualifier "between". The use of the conjunctive "and" in lieu of "to" is suggested so as to maintain claim language clarity.
- C) The recited "about 5 to 95%", "about 5 to 20%", "about 0 to 80%", "about 2 and 5%", "about 0.5 and 10%" per claims 2, 3, 5-7 and 11, respectively, constitute indefinite subject matter as per it not being readily ascertainable if the "about" is intended to qualify the firstly recited value only or the entire range.

#### Double Patenting

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-13 and 31-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-23 of copending Application No. 10/686,683 in view of Buecheler (U.S. 3,418,064). The claims (19-23) of U.S. copending application '683, drawn to an aqueous coating formulation containing solids, for enhancing image visualization and retention of reactive dye-based inks, comprising a) N-methylmorpholine-N-oxide, b) a cationic polymer or copolymer, c) a fabric softener, d) urea and e) ammonium salts of multifunctional weak acids selected from the group consisting of ammonium oxalate, ammonium tartrate and ammonium sulfate overlap in scope with the



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claims(1-13 and 31-33) of the instantly claimed invention drawn to an aqueous coating formulation containing solids, for enhancing image visualization and retention of acid dye-based inks, comprising a) a cationic polymer or copolymer, b) a fabric softener, c) urea, d) ammonium salts of multifunctional weak acids which include ammonium oxalate and ammonium tartrate, e) latex binder, f) additives which include wetting agents, defoamers and surfactants and g) tanning agent(s) wherein said tanning agent is either ethylene glycol monoethyl ether, thiodiethylene glycol or a mixture thereof. It would have been obvious to the skilled artisan to modify the claimed aqueous coating formulation of U.S. copending application'683 by adding a tanning agent such as thiodiethylene glycol and a latex binder as per Buecheler who teach the use, in aqueous printing formulations, of common printing assistants such as urea, thiodiethylene glycol, wetting agents and other conventional additives, sufficient to include a latex binder, known as a commonly used additive in aqueous printing formulations. "For example" is in noway limiting(col. 4, line 12 of Buecheler). Things believed to be known to those skilled in the art are often asserted by the examiner to be well known, or matters of common knowledge. If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. In re Malcolm, 1942 C.D. 589; 543 O.G. 440. If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

This is a provisional obviousness-type double patenting rejection.

21. Claims 1-13 & 31-33 are directed to an invention not patentably distinct from claims 19-23 of commonly assigned U.S. application no. 10/686,683, for reasons stated supra.

22. The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP 2302). Commonly assigned Application No. 10/686,683, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time

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the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 10249 or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

23. Applicant is reminded of the new rules for evidence of Common ownership set forth in the OG Notice of 12/26/01 "Guidelines Setting Forth a Modified Policy the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)" which states: Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicants) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person."

#### Conclusion

24. The additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Judy M. Reddick*  
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Art Unit 1713

JMR *JMR*  
05/13/04